

AMENDMENT UNDER 35 U.S.C. § 1.111
U.S. Application No.: 09/899,601
Attorney Docket No.: Q65349

REMARKS

General Remarks

Claims 1-29 are all the claims currently pending in the present application.

Claims 7-22 have been withdrawn. Claim 29 has been added.

Claims 25-28 stand rejected under both 35 U.S.C. § 112, first paragraph and 35 U.S.C. § 112, second paragraph. Claims 1, 4-6, and 23-28 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over TAPPI test Method T 205 Om-81 ("TAPPI"), and under 35 U.S.C. § 103(a) as allegedly unpatentable over Kline, in "Paper and Paperboard Manufacturing Fundamentals" ("Kline"). Applicants respectfully traverse these rejections as discussed below.

The Examiner indicates that Claims 2 and 3 would be allowable if rewritten in independent form. Applicants respectfully request that the rewriting of these claims be held in abeyance until the Examiner has considered the arguments presented herein with respect to Claims 1, 4-6, and 23-28.

A personal interview was conducted with the Examiner on July 15, 2004. A Statement of the Substance of the Interview follows.

Statement of the Substance of the Interview

At the interview conducted on July 15, 2004, the outstanding rejections of Claims 1, 4-6, and 23-28 were discussed. More specifically, Claim 1 was discussed in view of the Examiner's §103(a) rejection over TAPPI and §103(a) rejection over Kline. Applicants' arguments,

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presented herein, regarding the Examiner's failure to present a *prima facie* case of obviousness, were discussed. The Examiner disagreed with Applicant's arguments and maintained that the limitations of Claim 1 are obvious in spite of a failure of the prior art to teach or suggest the limitations or provide support that the claimed limitations are obvious.

Further, the Examiner clarified that the §103(a) rejection of Claims 1, 4-6 and 23-28 on page 3 of the Office Action is two separate §103(a) rejections: a §103(a) rejection over TAPPI, and a separate §103(a) rejection over Kline.

§112, first paragraph

Claims 25-28 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that the Claim 25 limitation "tank having said wire cloth at one of its boundaries" is not supported by the original specification.

Claim 28. With respect to Claim 28, Applicants respectfully submit that this rejection is in error. Claim 28 depends from Claim 1, not from Claim 25, and does not recite the "tank having said wire cloth at one of its boundaries." Accordingly, Applicants respectfully request that the §112, first paragraph, rejection of Claim 28 be reconsidered and withdrawn.

Claims 25-27. With respect to Claims 25-27, Applicants respectfully submit that the original specification of the present application does, indeed, provide adequate written description for these claims.

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There is no *in haec verba*—i.e., word for word—requirement for satisfying the written description requirement. That is, the newly added claim limitations can be supported in the specification through express, implicit, or inherent disclosure.² Additionally, Applicants can show possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.³ In the present case, Applicants submit that the specification does, indeed, provide sufficient support for the claimed limitation that “[the] tank having said wire cloth at one of its boundaries”. For example, as shown in Figure 2 of the present application, there is shown stirring tank 2 having a wire cloth disposed at its lower (as shown in that figure) boundary.

Therefore, Applicants respectfully request that the §112, first paragraph, rejection of Claims 25-27 be reconsidered and withdrawn.

§112, second paragraph

Claims 25-28 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Specifically, the Examiner asserts that the Claim 25 limitation “[the] tank having said wire cloth

² See MPEP § 2163(I)(B).

³ *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).
See also MPEP § 2163(I).

at one of its boundaries” is indefinite because it is unclear if the cloth is part of the housing or a part adjacent to the tank or in the vicinity of it.

Claim 28. With respect to Claim 28, Applicants submit that this rejection is in error for the same reasons as presented above with respect to the §112, first paragraph rejection of Claim 28, and respectfully request that the §112, second paragraph, rejection of Claim 28 be reconsidered and withdrawn.

Claims 25-27. Applicants respectfully submit that Claims 25-27 are not indefinite; they are merely broad. The breadth of a claim is not to be equated with indefiniteness.⁴ By not reciting that the wire cloth is part of the tank, adjacent to the tank, or in the vicinity of the tank, the claims encompass many various arrangements. The definition of the method in such broad terms does not make the claims indefinite.

Therefore, Applicants respectfully request that the §112, second paragraph, rejection of Claims 25-27 be reconsidered and withdrawn.

TAPPI

Regarding the Examiner’s §103(a) rejection of Claims 1, 4-6, and 23-28 over TAPPI, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

⁴ *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

First, Applicants submit that the Examiner's interpretation of the TAPPI method is mistaken. The Examiner asserts that "the TAPPI test ... [is] silent regarding how the pulp and water are mixed, i.e., it only says that the sample is diluted to disintegrate."⁵ Instead, however, the TAPPI test method describes very specific procedures for mixing the pulp.

In section 7.1 Disintegration, the TAPPI test specifically teaches combining water and a pulp sample, and subsequently stirring them together to disintegrate the fibers. In particular, the TAPPI test method discloses "Dilute the sample to 2,000 ml ... with water ... and disintegrate in the standard disintegrator at 3,000 rpm to 50,000 revolutions"⁶

In section 7.2 Sheetmaking, the TAPPI test specifically discloses that a sheet machine is first half-filled with water, a sample of dilute stock is poured into the machine, and then more water is added.⁷ It is then, only in section 7.2.2, that the TAPPI test discloses stirring the water and dilute stock together in a very specific manner and for a very specific period of time with a stirrer, and at the end of stirring specifically notes that the stirrer should be moved "just sufficient to dislodge any long fibers clinging to the edges of the holes in the stirrer, but not enough to swirl the suspension appreciably...."⁸

⁵ Office Action at page 3, item 6, paragraph 2, lines 5-7.

⁶ The TAPPI test method at page 2, item 7.1.1, lines 1-3.

⁷ The TAPPI test method at page 2, section 7.2.1, lines 1-8.

⁸ The TAPPI test method at page 2, section 7.2.2, lines 1-10.

Thus, the TAPPI test does, indeed, teach a specific manner of how the pulp and water are mixed. Further, there is no teaching or suggestion that other methods may be used to stir the pulp and water.

Second, the Examiner asserts that one of ordinary skill in the art would recognize that the stirring can be done by “a) diluting the pulp first and then disintegrating; b) by adding the pulp to the tank/stirrer adding water, and then stirring or; c) by adding water to the tank, stirring the water and adding the pulp to the stirred water.”² Again, Applicants submit that the Examiner is mistaken. Instead, it is Applicants who have disclosed method (c). Accordingly, the Examiner impermissibly is using Applicants’ own disclosure against them. This he cannot do. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure.¹⁰

Third, the Examiner makes the unsupported assertion that “one of ordinary skill in the art would recognize the third alternative as a viable, obvious alternative for the pulp diluting process.”¹¹ However, Applicants submit that mere allegations by the Examiner, that the claimed subject matter is obvious in view of the prior art, do not create a presumption of

² Office Action at page 3, item 6, paragraph 2, lines 7-10.

¹⁰ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also *Uniroyal, Inc. v. Rudcan-Wiley, Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

¹¹ Office Action at page 3, item 6, paragraph 2, lines 10-12.

unpatentability.¹² It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness.¹³ In this case, however, the Examiner fails to provide any factual basis, or even evidence, to support his conclusion of obviousness.

Moreover, an Examiner may not rely on Official or Judicial Notice at a point where patentable novelty is argued, but must come forward with pertinent prior art.¹⁴ Yet, in the present case, the Examiner's unsupported assertion goes directly to the point which Applicants argue is novel.

For at least the above reasons, Applicants submit that the TAPPI test fails to establish a *prima facie* obviousness of Claim 1, and that Claims 4-6 and 23-28 are patentable for at least the same reasons. Therefore, Applicants respectfully request that the Examiner provide evidence, including pertinent prior art, to support his position, as required.¹⁵ Otherwise, Applicants respectfully request that the §103(a) rejection of Claims 1, 4-6, and 23-28 over TAPPI be reconsidered and withdrawn.

¹² *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963).

¹³ *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

¹⁴ *Ex parte Cady*, 148 USPQ 162 (Bd. App. 1965).

¹⁵ *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).

Kline

Regarding the Examiner's §103(a) rejection of Claims 1, 4-6, and 23-28 over Kline, Applicants respectfully submit that, as with TAPPI, the Examiner similarly has failed to establish a *prima facie* case of obviousness.

Kline teaches feeding chunks into a mixture of chunks and water that are being stirred. However, Kline fails to teach or suggest that the water is in a stirred condition before the chunks are added. Instead, the Examiner relies on bald assertions that it would have been obvious to one of ordinary skill in the art to do so. As such, Applicants submit that the Kline reference fails to establish a *prima facie* obviousness of any of Claims 1, 4-6, and 23-28 for at least the same reasons as presented above with respect to TAPPI.

Furthermore, Applicants submit that not only does Kline fail to teach or suggest the limitations of the present invention as recited in any of Claims 1, 4-6, and 23-28, but Kline specifically teaches away from the modifications of the prior art which would be required to arrive at the invention as claimed. Specifically, Kline explains that "differences between products are the result of the way in which the fibers are treated and the manufacturing process used in making each one."¹⁶ Kline further explains that "every step [of the process] will have an impact on the final properties of the product," and that "[e]ach step in the process remains important to the final product." These statements, taken together with the whole of the Kline

¹⁶ Kline at page 16, lines 6-8.

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disclosure, suggest that even a small change in the process of the papermaking may make an enormous difference to the resultant product. Therefore, based on this reference, it would not have been obvious to one of skill in the art to modify a known process in order to arrive at the claimed invention.

Therefore, for at least the above reasons, Applicants submit that Kline fails to establish a *prima facie* obviousness of Claims 1, 4-6 and 23-28. Therefore, as requested above, Applicants again respectfully request that the Examiner provide evidence, including pertinent prior art, to support his position, as required.¹⁷ Otherwise, Applicants respectfully request that the §103(a) rejection of Claims 1, 4-6, and 23-28 over Kline be reconsidered and withdrawn.

New Claim

Applicants have added new Claim 29 in order more fully to cover various aspects of Applicants' invention as disclosed in the specification. Applicants submit that Claim 29 is patentable over the cited references for at least the reasons presented above with respect to Claims 1, 4-6 and 23-28.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

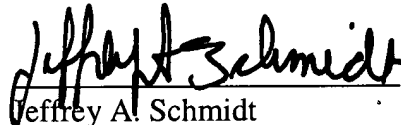
¹⁷ *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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